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9/20/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Brian Joseph McNamara**

Application No.: **09/450,912**

Examiner: **Sheila B. Smith**

Filing Date: **11-29-1999**

Group Art: **2685**

Title: **Dual Band Tuning**

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office via facsimile transmission to facsimile number (703)308-6306, to the attention of: Examiner Sheila B. Smith on June 28, 2002.

6-28-2002
Date

Denise Grisack

The Commissioner for Patents
Washington, DC 20231

RESPONSE TO OFFICE ACTION (PAPER NUMBER 6)

Sir:

Applicant has received an Office Action alleging that the previous Response filed by Applicant on March 26, 2002 (mailed with a Certificate of Mailing under 37 C.F.R. § 1.8 on March 19, 2002) is "not fully responsive to the prior Office Action. Particularly, the Patent and Trademark Office (Office) alleged:

The reply filed on 3/26/02 is not fully responsive to the prior Office Action because: The applicant did not address the matter of the statutory type double patenting. Since the period for reply set forth in the prior Office action has

expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

Applicant respectfully traverses the allegation that the previous reply is not fully responsive and that payment of extension fees are necessary to avoid abandonment of this application. Particularly, the previous Office Action did not contain a statutory type double patenting rejection. Rather, the Office Action contains a provisional double patenting rejection. Particularly, the previous Office Action stated:

Claims 1-12 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-12 [sic] of copending Application No. 09/325,478. This is a provisional (underling in original) double patenting rejection since the conflicting claims have not in fact been patented.

Quite simply, a provisional double patenting rejection is not a rejection and, thus, Applicant is not required to respond to it. As stated in M.P.E.P. 804, heading I. B:

I INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED

B. Between Copending Applications-Provisional Rejections

Occasionally, the examiner becomes aware of two copending applications filed by the same entity... that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. [Citations omitted]. The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw the rejection and permit the application to issue as a patent, thereby converting the "provisional" double

patenting rejection in the other application (s) into a double patenting rejection at the time the application issues as a patent.

If the "provisional" double patenting rejection in both applications are the only rejections remaining in the applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent. (Underlining added)

Based on the above-quoted MPEP passage and, particularly, the underlined portions, it is quite clear that the purpose of a provisional double patenting rejection is merely "making applicant aware of the potential double patenting problem if one of the applications became a patent", thus clearly denoting that a provisional double patenting rejection is merely informational and is not a rejection. Further, and perhaps even more importantly, the passage clearly states, in permissive, rather than mandatory language, that "{t}he merits of such a provisional rejection can be addressed by ... the applicant Accordingly, Applicant clearly is not required to respond to a provisional double patenting rejection.

As further support, note that the above quoted section of the M.P.E.P. makes clear that the Examiner does not even have to make a provisional double patenting rejection, but is merely permitted to make it. It further makes clear that the rejection is allowed to persist until one of the patents issues whereupon it should be converted into an actual double patenting rejection.

Thus, the response to the previous Office Action was fully responsive and no further response or extension fee is necessary or should be charged against Applicant in connection with the present Response.

In any event and in response to the provisional double patenting rejection, Applicant intends to allow copending application No. 09/325,478 to become abandoned but does not intend

to expressly abandon it at this time. Accordingly, the provisional double patenting rejection will never mature into an actual double patenting rejection.

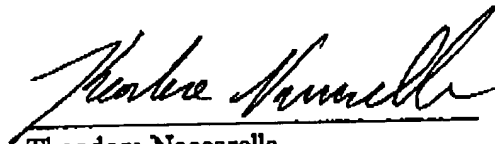
Even further, under M.P.E.P. § 714.03, when an Examiner believes a response to an Office Action to be incomplete but that the Applicant made a good faith attempt to fully respond, the Examiner has the options of (1) setting a new time period for Applicant to complete the reply pursuant to 37 C.F.R. § 1.135(c) and thus avoid the need to pay extension fees or (2) simply accepting the Amendment and reasserting the rejection in the next Office Action in addition to the Examiner's selected option of (3) merely notifying Applicant of the failure without providing additional time to correct the defect. As clearly discussed in M.P.E.P. § 714.03, where the Applicant clearly made a bona fide attempt to advance the application to final action, the Examiner should select option (1) or option (2), rather than option (3), as was selected by the Examiner. Even further, when an Examiner elects the third option (as in this case) of simply notifying the Applicant that the reply must be completed in the remaining period for reply to the non-final Office Action, he should make all reasonable attempts to notify the Applicant by telephone before issuing a written Office Action. The Examiner did not do this in this case.

In the Response to the previous Office Action, Applicant fully and extensively replied to all rejections except the provisional double patenting rejection, thus clearly evidencing a bona fide attempt to fully respond to the Office Action. Thus, even if the failure to respond to the provisional double patenting rejection made the Response incomplete (which, as set forth above, it clearly did not), the Examiner should have selected either of the other options. Further, even under the improperly selected third option, the failure to attempt to contact applicant's counsel by telephone was highly irregular.

In summary, the previous response was fully responsive and the Office should withdraw the notice of incomplete response and requirement for payment of extension fees. In any event, Applicant has herein responded to the provisional double patenting rejection.

In view of the foregoing remarks, this application is now in condition for allowance. Applicant respectfully requests the Examiner to issue a Notice of Allowance at the earliest possible date. The Examiner is invited to contact Applicant's undersigned counsel by telephone call in order to further the prosecution of this case in any way.

Respectfully submitted,



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Attorneys for Applicant

M:\Naccarella\CLIENTS\MA-Com\25779-A USA\Pro\Response to Office Action dated 6-18-02.wpd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Brian Joseph McNamara**

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Examiner: **Sheila B. Smith**

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CERTIFICATE OF FACSIMILE

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6-28-2002
Date

Denise Grisack
Denise Grisack

The Assistant Commissioner
for Patents
Washington, DC 20231

AMENDMENT TRANSMITTAL LETTER

Sir:

Transmitted herewith is an Amendment for filing in connection with the above-identified application.

- () Small entity status of this application under 37 CFR § 1.9 and 37 CFR § 1.27 has been established by a verified statement previously submitted.
- () A verified statement claiming small entity status under 37 CFR § 1.9 and 37 CFR § 1.27 is enclosed.

Application No. 09/450,912

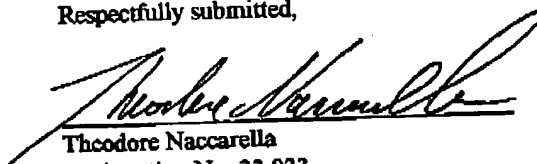
Docket No. 17481

The fee has been calculated and is transmitted as shown below:

| CLAIMS AS FILED | | | | | |
|--|--|-------------------------------------|------------------|---------------|--------------|
| | Claims Remaining After Amendment | Highest # Previously Paid For | Present Extra | Rate | Calculations |
| Total Claims | 21 - | 21 | 0 | \$22 | \$0.00 |
| Independent Claims | 2 - | 2 | 0 | \$82 | \$0.00 |
| Multiple Dependent Claim(s), if applicable | | | | \$270 = | \$0.00 |
| | | | | Total Fee: | \$0.00 |

- () No additional fee is required for amendment.
- () Applicant hereby petitions for a _ 0 month extension. Please charge Deposit Account No. in the amount of \$_. This sheet is attached in duplicate
- () Please charge Deposit Account No. In the amount of
A duplicated copy of this sheet is enclosed.
- () A check in the amount of to cover the filing fee is enclosed.
- (X) The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-5425
A duplicate copy of this sheet is enclosed.
- (X) Any additional filing fees required under 37 CFR 1.16.
- (X) Any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,



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FACSIMILE COVER SHEET

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Please deliver the facsimile transmitted herewith to:

Name: Examiner Sheila Smith

From: Theodore Naccarella

Re: 09/450,912

S&L Docket Number: 25,779-A USA

A total of 10 pages, including this cover sheet will be transmitted.

Confirmation copy sent by mail: YES X NO

Name of Operator: Denise Grisack

Date Sent: June 28, 2002 Time Sent: 11:00 AM EST

Facsimile Number of Recipient: 703-308-6306 / 703-746-6027

Notes: Please see attached Amendment dated June 28, 2002. Thank you.

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